

This Page Is Inserted by IFW Operations  
and is not a part of the Official Record

## **BEST AVAILABLE IMAGES**

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images may include (but are not limited to):

- BLACK BORDERS
- TEXT CUT OFF AT TOP, BOTTOM OR SIDES
- FADED TEXT
- ILLEGIBLE TEXT
- SKEWED/SLANTED IMAGES
- COLORED PHOTOS
- BLACK OR VERY BLACK AND WHITE DARK PHOTOS
- GRAY SCALE DOCUMENTS

**IMAGES ARE BEST AVAILABLE COPY.**

**As rescanning documents *will not* correct images,  
please do not report the images to the  
Image Problem Mailbox.**

**REMARKS**

In the Office Action, the Examiner rejected claims 1-19, 21, 24-35, 37, 39-53, 55 and 56. Claims 20, 22, 23, 36, 38 and 54 remain withdrawn from consideration. By this Response, Applicants amended claims 1, 8, 17, 26, 31, 43, 44, 45, 46, and 49. No new matter has been added by the foregoing amendments. In view of the foregoing amendments and following remarks, the Applicants respectfully request reconsideration and allowance of the present application.

**Claim Rejections – 35 U.S.C. § 112, Second Paragraph**

The Examiner rejected claims 1-19, 21, 24-35, 37, 39-53, 55, and 56 under U.S.C. § 112, Second Paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. The Applicants respectfully traverse this rejection.

The Applicants respectfully stress that, although the Examiner may take exception to the terms used in the claims, the patentee may be his own lexicographer. *Ellipse Corp. v. Ford Motor Co.*, 171 U.S.P.Q. 513 (7<sup>th</sup> Cir. 1971), *aff'd*. 613 F.2d 775 (7<sup>th</sup> Cir. 1979), *cert. denied*, 446 U.S. 939 (1980). The terms employed in the claims are clearly described in the specification, which provides adequate teaching for one skilled in the art to make and use the claimed invention. The Examiner is also reminded not to equate breadth of a claim with indefiniteness. *In re Miller*, 441 F.2d 689, 169 U.S.P.Q. 597 (C.C.P.A. 1971). For these reasons, the Applicants believe that the Examiner's rejections are improper.

Regarding independent claims 1, 17, 31, 43, and 49, the Examiner stated:

It is unclear to claim that the stabilizer system stabilizes independent from shock absorption for the reason that the invention itself would inherently absorb shock to at least some degree and not be completely free from shock absorption. Furthermore, it is unclear if there is being claimed a

separate shock absorbing system on the vehicle. Claim 31 positively claims a separate shock absorbing system, but Elements 20 are springs and cannot accurately be called a shock absorption system.

Paper No. 9, p. 2. Applicants respectfully traverse the Examiner's rejection. The Examiner appears to be equating claim breadth with indefiniteness. Each of the independent claims clearly recites stabilization independent from shock absorption. However, the Examiner believes that spring assemblies 20 are not accurately a shock-absorption system. The Applicants stress that the spring assemblies 20 are simply one embodiment of possible shock absorbers, which are separate and independent from cross-stabilization as set forth in each of the independent claims. Therefore, the Applicants believe that the Examiner is improperly interpreting the broad terminology of shock-absorption as indefinite even though the present disclosure describes an embodiment of spring assemblies 20. For these reasons, the Applicants believe that the Examiner's rejections are improper.

Regarding dependent claim 12, the Examiner stated:

It is not accurate and clear to claim that the "variable chamber assembly is disposed along each of the first and second conduits". As this claim reads, it would require the chambers to be disposed along or between portions of the conduits. This is not the case. The chambers are within the cylinders and are not accurately able to be claimed as being disposed along the conduits.

Paper No. 9, p. 2. Again, the Applicants respectfully traverse this rejection. The Examiner appears to be equating claim breadth with indefiniteness. Here, the Applicants respectfully direct the Examiner to Fig. 8, which illustrates compensators 160 and 162 disposed along the connector 28 and 30 between the piston assemblies 102, 104, 106, and 108. *See* Application, Fig. 8. For this reason, the Applicants believe that the Examiner's rejection is improper and should not stand.

Regarding dependent claim 13, the Examiner further stated that the “variable volume chamber does not comprise a diaphragm.” Paper No. 9, p. 3. Again, the Applicants respectfully direct the Examiner to Fig. 8, which illustrates the compensators 160 and 162 disposed along the connector 28 and 30. *See* Application, Fig. 8. As described in the present application, these compensators 160 and 162 may comprise control members 164 and 166, which may include piston-cylinder assemblies, spring assemblies, diaphragms, flexible seals, and so forth. *See* Application, p. 10, ll. 14-17. For this reason, the Applicants believe that the Examiner is equating claim breadth with indefiniteness. Therefore, the Applicants respectfully request that the Examiner withdraw the foregoing rejection of claim 13.

Regarding claim 14, the Examiner stated that the “variable volume chamber does not comprise a spring loaded piston assembly.” Paper No. 9, p. 3. Once again, the Examiner has failed to recognize the disclosure of compensators 160 and 162, which may include spring assemblies as discussed above. *See* Application, p. 10, ll. 15-17. For this reason, the Applicants respectfully request that the Examiner withdraw the rejection of claim 14.

**Claim Rejections – 35 U.S.C. § 102(b)**

The Examiner rejected independent claims 1, 17, 43, and 49, and dependent claims 2-5, 10-12, 15, 18-19, 21, 28, 44-48, 50, 53, 55 and 56 under 35 U.S.C. § 102(b) as anticipated by MacLeod (U.S. Patent No. 5,794,966). The Examiner also rejected claims 1-5, 10-12, 15, 17-19, 21, 28, 31-35, 37, 39-50, 53, 55, and 56 under 35 U.S.C. § 102(b) as anticipated by Heyring (U.S. Patent No. 5,447,332). Applicants respectfully traverse these rejections.

### ***Legal Precedent***

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under section 102, a single reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, the Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the *identical* invention “*in as complete detail as contained in the . . . claim*” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

### ***Deficiencies of MacLeod***

First, each of the independent claims 1, 17, 43, and 49 recite a piston-cylinder assembly having a spring assembly or hydraulically and springably cross-balancing. In sharp contrast, the shock absorbers 10a and 10b of MacLeod are entirely hydraulic assemblies, which are completely devoid of any sort of spring assembly. For this reason, the MacLeod reference cannot anticipate independent claims 1, 17, 43, and 49.

Second, independent claims 1, 17 and 49 disclose piston-cylinder assemblies and suspension members for “*crosswise stabilization, independent from shock absorption.*” Similarly, independent claim 43 recites “cross-balancing orientations, *separate from absorbing shock.*” In contrast, the MacLeod reference discloses “a method of fluidly interconnecting modified tubular hydraulic *shock absorbers* comprising the suspension system in a manner facilitating various modes of suspension performance.” Col. 1, ll. 7-

14. The MacLeod reference further teaches that “*shock absorbers*” are *integral* to the disclosed vehicular suspension system. Col. 3, ll. 22-35 and 49-53. Therefore, given that MacLeod discloses only hydraulically interconnected shock absorbers, rather than piston-cylinder assemblies independent from shock absorption, the MacLeod reference fails to teach each and every element of the instant claims. Accordingly, MacLeod cannot anticipate independent claims 1, 17, 43, and 49.

The MacLeod reference also fails to teach or suggest the unique features recited in the claims depending from amended independent claims 1, 17, 43, and 49. Accordingly, the foregoing dependent claims are believed to be patentably distinct over the MacLeod reference for the reasons provided above and also for additional unique features recited in the subject claims.

In view of the foregoing deficiencies, the Applicants respectfully request that the Examiner withdraw all outstanding rejections under 35 U.S.C. § 102(b) based on MacLeod.

***Deficiencies of Heyring***

Again, the Applicants stress that Heyring fails to disclose the spring assemblies recited in each of the independent claims 1, 17, 31, 43, and 49. Instead, the vehicle suspension system disclosed by Heyring is entirely hydraulic, rather than having any sort of spring assemblies disposed within piston-cylinder assemblies as set forth in the instant claims. Specifically, the Heyring reference discloses double-acting rams 13, 14, 17, and 18, which have first and second chambers that vary in volume of fluid within those chambers. *See* Heyring, abstract. However, the Heyring reference is absolutely devoid of any teaching or suggestion of spring assemblies disposed within these rams 13, 14, 17, and 18. In view of this deficiency, the Heyring reference cannot anticipate independent claims 1, 17, 31, 43, and 49 and their corresponding dependent claims. Therefore, the

Applicants respectfully request that the Examiner withdraw all outstanding rejections under 35 U.S.C. § 102(b) based on Heyring.

**Claim Rejections – 35 U.S.C. § 103(a)**

Under 35 U.S.C. § 103(a), the Examiner rejected claims 6-9, 14, 24-27, 30, 51, and 52 as unpatentable over MacLeod in view of de Molina (U.S. Patent No. 5,823,306), or alternatively as unpatentable in view of Heyring in view of de Molina, or alternatively as unpatentable in view of Heyring in view of Kindermann et al. (U.S. Patent No. 5,066,041) and further in view of de Molina. In addition, the Examiner rejected claims 13 and 29 as unpatentable over MacLeod in view of Lutz (U.S. Patent No. 3,625,321), alternatively as unpatentable over Heyring in view of Lutz, or alternatively as unpatentable over Heyring in view of Kindermann et al. and further in view of Lutz. Further, the Examiner rejected claim 16 as unpatentable over MacLeod, alternatively as unpatentable over Heyring, or alternatively as unpatentable over Heyring in view of Kindermann et al. Finally, the Examiner rejected claims 1-5, 10-12, 15, 17-19, 21, 28, 31-35, 37, 39-50, 53, 55, and 56 as unpatentable over Heyring in view of Kindermann et al.

As discussed in detail below, the Applicants respectfully traverse these rejections. First, the Applicants reiterate that neither MacLeod nor Heyring teach or suggest a spring assembly, as recited in independent claims 1, 17, 31, 43, and 49. Second, the additional references cited by the Examiner do not obviate the deficiencies of the MacLeod and Heyring references. Third, there is no motivation nor suggestion to combine the cited references. In fact, some of the references actually teach away from one another, thereby precluding the Examiner's proposed combinations.

***Legal Precedent***

First, the burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). The Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Moreover, a statement that the proposed modification would have been “well within the ordinary skill of the art” based on individual knowledge of the claimed elements cannot be relied upon to establish a *prima facie* case of obviousness without some *objective reason to combine* the teachings of the references. *Ex parte Levensgood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d. 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d. 1161 (Fed. Cir. 1999).

Second, when prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the



combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Third, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983); M.P.E.P. § 2145. Moreover, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959); see M.P.E.P. § 2143.01.

Fourth, in order to rely on equivalence as a rational supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents. *In re Ruff*, 256 F.2d 590, 118 U.S.P.Q. 340 (CCPA 1958); see also M.P.E.P. § 2144.06.

### ***Deficiencies of Cited References***

As discussed in detail above, each of the independent claims 1, 17, 31, 43, and 49 recite a piston-cylinder assembly having a spring assembly or hydraulically and springably cross-balancing. In addition, independent claims 1, 17, and 49 recite "crosswise stabilization, independent from shock absorption." Similarly, independent claim 31 recites piston-cylinder assemblies "separate from a shock-absorption system." Finally, independent claim 43 recites "cross-balancing orientations, separate from absorbing shock." For the reasons discussed in detail above, the MacLeod and Heyring references fail to teach or suggest these features. In fact, both of these references clearly

teach a *principle of operation* using *hydraulics*, rather than any sort of spring assemblies. The Applicants further stress that the secondary references do not obviate the deficiencies of these primary references in each of the foregoing rejections under 35 U.S.C. § 103(a).

### ***Improper Combinations***

In some of the foregoing rejections, the Examiner cited de Molina for its disclosure of a spring 56. However, the Applicants submit that there is no reason to combine the de Molina reference with either of the MacLeod or Heyring references. In fact, the MacLeod and Heyring references clearly *teach away* from application of a spring assembly with the hydraulic systems disclosed in each of those references.

Turning first to MacLeod, the reference discloses fluid accumulators 40 or 60 (not spring assemblies) to allow for the displacement of fluid by the piston rods 28 as they move in and out of the interior chambers 18. *See* MacLeod, Figs. 3 and 4; col. 7, ll. 29-41; col. 8, ll. 1-3. Similarly, the Heyring reference discloses accumulators 23, 24, 29, and 30 disposed within conduits 8, 10, 8a and 10a, such that the accumulators provide resilience in the double-acting rams 13, 14, 17 and 18. *See* Heyring, Fig. 1; col. 5, ll. 22-47. Clearly, both the MacLeod and Heyring references rely solely on a *principle of operation of hydraulics*, including the use of accumulators. Thus, the Examiner's proposed combination of MacLeod or Heyring with the de Molina reference cannot stand, because such a combination would change the *principle of operation* and render the cited references *unsatisfactory for their intended purposes* as recited in each respective reference.

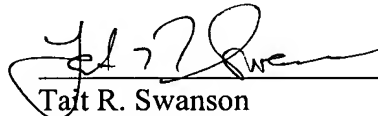
For these reasons, the Applicants stress that the de Molina reference cannot be combined with either MacLeod or Heyring. Thus, the Applicants respectfully request that the Examiner withdraw these combinations and allow all pending claims.

**Conclusion**

The Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

Date: March 22, 2004

  
Taft R. Swanson  
Registration No. 48,226  
FLETCHER YODER  
P.O. Box 692289  
Houston, TX 77269-2289  
(281) 970-4545